

REMARKS

In view of the following remarks, reconsideration and allowance are requested.

Status of Claims

Claims 1-15 are pending in the application. Claims 13-15 were withdrawn from consideration in the Office Action.

Claims 10 and 12 stand rejected to in the Office Action under 35 U.S.C. 102(b).

Claims 1-12 stand rejected under 35 U.S.C. 103(a).

The remarks in this response place the pending claims in condition for allowance.

35 U.S.C. 102(b)

Claims 10 and 12 stand rejected under 35 U.S.C. 102(b) in the Office Action as allegedly being anticipated by U.S. Patent No. 5,314,539 to Brown et al. ("Brown"). Claim 10 is an independent claim and Claim 12 depends upon Claim 10.

In order for a claim to be anticipated by the prior art and rejected under 35 U.S.C. § 102, a single prior art reference should disclose each element of the claim under consideration. *Minnesota Mining and Mfg. Co. v. Johnson & Johnson Orthopedics, Inc.*, 976 F.2d 1559, 1565 (Fed. Cir. 1992).

However, Claims 10 and 12 are patentable since Brown does not anticipate at least one feature of the claim. For instance, Brown does not anticipate the feature below from Claim 10:

"a flexible substrate passing along said plurality of cylindrical rollers wherein said flexible substrate is curved so

that said substrate has a concave surface in contact with said plurality of cylindrical rollers..."

In particular, Claim 10 states that "said substrate has a **concave surface**." However, Fig. 7 of Brown shows that the convex surface of the substrate contacts the plurality of cylindrical rollers 11, 13, 18 and not the concave surface of the substrate. In Brown, the concave surface of the substrate M is in contact with a backing roller 10.

Since a feature of Claim 10 differs from the disclosed features of Brown, all of the features of Claim 10 are not anticipated by Brown. Therefore, the 35 U.S.C. 102(b) rejection to Claims 10 and 12 should be removed and those claims should be allowed.

35 U.S.C. 103

Claims 1-12 stand rejected to in the Office Action under 35 U.S.C. 103(a) for allegedly being obvious over Brown in view of the prior art within the application, and in further view of U.S. Patent No. 5,462,602 to Mislano et al. ("Mislano"). Of the rejected claims, Claims 1, 3, and 10 are independent claims.

A 35 U.S.C. § 103 claim rejection requires a showing of some teaching, suggestion, or motivation in the prior art that supports the combination of the features from the prior art references. *Ashland Oil, Inc. v. Delta Resins & Refractories, Inc.*, 776 F.2d 281 (Fed. Cir. 1985). Furthermore, Obviousness must be determined by considering (1) the scope and content of the prior art, (2) the differences between the prior art and the patent claim, (3) the level of ordinary skill in the pertinent art, and (4) secondary considerations, if any, of non-obviousness. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966).

Claim 1 is patentable because the suggested combination in the Office Action fails to teach all of the features of the claim to those of ordinary skill in the art. For example, the cited prior art does not teach or suggest the combination of the features below of:

"wherein the substrate is in contact with each of the plurality of cylindrical rollers with a wrap angle kept positive to create a force in a direction pressing the flexible substrate against the plurality of cylindrical rollers."

The above-cited features are disclosed in the application on page 6, lines 11-15 and shown in Fig. 4C. Moreover, these features are taught on page 7, lines 1-18 of the application in which "the substrate is in contact with each of the plurality of cylindrical rollers with a wrap angle kept positive to create a force in a direction pressing the flexible substrate against the plurality of cylindrical rollers." For instance, page 7, lines 8-11 discloses that "...provided that the flexible substrate 512 contacts each of the cylindrical rollers 511 with a wrap angle 508 which is positive, a component force 506 in a direction pressing the substrate against the electrode is generated."

In contrast, the plurality of cylindrical rollers of Brown merely press the substrate toward the backing roller 10 as shown in Fig. 7.

Furthermore, there is no motivation to modify the cited prior art in the application to contain the cylindrical rollers of Brown. Since the cylindrical roller 11, part of support means 9, functions together with the backing roller 10, also part of support means 9, there is no reason to pick only the cylindrical roller 11 and incorporate it into the cited prior art in the application. Additionally, it would be unclear how the cylindrical rollers are used in the cited prior art of the

application if it is modified to include the cylindrical rollers of Brown.

Therefore, Claim 1 is patentable and the 35 U.S.C. 103 rejection should be removed since (1) the cited prior art does not teach or suggest the combination of at least the above-cited features, (2) there are differences between the prior art and the patent claim, and (3) no motivation has been established to form the suggested combination. Hence, Claim 1 and the dependent Claim 2 should be allowed.

Since Claim 3 also comprises the above-cited features for Claim 1, Claim 3 is patentable for at least the same reasons as for Claim 1.

Claim 10 is patentable because the suggested combination in the Office Action fails to teach all of the features of the claim to those of ordinary skill in the art. For example, the cited prior art does not teach or suggest the combination of the features below of:

"a flexible substrate passing along said plurality of cylindrical rollers wherein said flexible substrate is curved so that said substrate has a concave surface in contact with said plurality of cylindrical rollers..."

In particular, Claim 10 states that "said substrate has a concave surface." However, Fig. 7 of Brown shows that the convex surface of the substrate contacts the plurality of cylindrical rollers 11, 13, 18 and not the concave surface of the substrate. In Brown, the concave surface of the substrate M is in contact with a backing roller 10. Hence, these features are not taught in the cited prior art. Since these features are

not taught in the cited prior art, these features could not be combined to reject Claim 10 under 35 U.S.C. 103.

Therefore, the 35 U.S.C. 103 rejection should be removed and Claim 10 should be allowed.

Dependent Claims 2, 4-9, 11-12

The remaining rejected dependent claims are allowable for the reasons that their respective independent claim is allowable and for reciting allowable subject matter in their own right. Independent consideration and allowance of the dependent claims are respectfully requested.

For example, Claims 2 and 4 are patentable since these claims provide advantages not taught in the cited prior art. The Applicants' contend that these advantages are not obvious (see MPEP 2144.05: Obviousness of Ranges).

Moreover, secondary considerations of non-obviousness can include any commercial success of the claimed invention, any long felt but unsolved need prior to the claimed invention, whether others have tried but failed to find a solution to the problem at hand, and any copying of the invention by others. *B.F. Goodrich Co. v. Aircraft Braking Sys. Corp.*, 72 F.3d 1577, 1582 (Fed. Cir. 1996).

If the radius R is smaller than 0.5m, the height of the film formation chamber has to be increased in order to obtain a sufficient film formation region. If the radius is greater than 10m, the wrap angle is not sufficiently large. Hence, some of the advantages of the application (e.g., preventing the formation of wrinkles) may not be achieved. Therefore, the 35 U.S.C. 103 rejections to Claims 2 and 4 should be removed since the advantages of those claims are not obvious.

CONCLUSION

In view of the amendments and remarks, Applicants believe that Claims 1-12 are in condition for allowance and ask that those pending claims be allowed.

The foregoing comments made with respect to the positions taken by the Examiner are not to be construed as acquiescence by the Applicants with other positions of the Examiner that have not been explicitly contested. Accordingly, Applicants' arguments for patentability of a claim should not be construed as implying that there are not other valid reasons for patentability of that claim or other claims.

Attached is a mark-up version of the changes being made by the current amendment.